



Counselors by Intellectual Property

Wong, Cabello, Lutsch, Rutherford & Brucculeri, P.C.

RECEIVED
CENTRAL FAX CENTER

OCT 10 2005

20333 SH 249, Suite 600

Houston, Texas 77070

Direct: 832-446-2416

Fax: 832-446-2424

smcdermott@counselip.com

FACSIMILE TRANSMISSION COVER SHEET

Date: **October 10, 2005**

To: **MAIL STOP AF**

Fax: **571-273-8300**

Examiner: **Edwin A. Leon**

From: **Sean McDermott**

Customer No: **29855**

Client/Matter: **175-0002US**

Serial No.: **10/619,535**

Re: *Please see the attached*

Pages (including cover page): **9**

Received in the United States Patent and Trademark Office

- **Notice of Appeal Form PTO/SB/31 (1-page);**
- **Duplicate copy of Notice of Appeal (1-page);**
- **Pre-Appeal Brief Request for Review Form PTO/SB/33 (1-page);**
- **Pre-Appeal Brief Request for Review (5-pages).**

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0851-00xx
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 175-002US	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>October 10, 2005</u> Signature <u>[Signature]</u> Typed or printed name <u>Sean McDermott</u>		Application Number 10/619,535	Filed 11 July 2003
		First Named Inventor Tavis D. Schriefer	
		Art Unit 2833	Examiner Edwin A. Leon
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>[Signature]</u> Signature Sean McDermott Typed or printed name 832-446-2416 Telephone number <u>October 10, 2005</u> Date	
<input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)			
<input checked="" type="checkbox"/> attorney or agent of record. 49,000 Registration number			
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER

OCT 10 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/619,535 Confirmation No.: 7506
Applicant : Tavis D. Schriefer
Entitled : Multiple Degrees of Freedom Connectors and Adapters
Filed : July 11, 2003
TC/A.U. : 2833
Examiner : Edwin A. Leon.

Docket No. : 175-0002US
Customer No. : 29855

MAIL STOP AF
Commissioner for Patents
PO BOX 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This is a Pre-Appeal Brief Request for Review as provided by the "New Pre-Appeal Brief Conference Pilot Program" outlined in the Official Gazette Dated 12 July 2005. This Request is being filed concurrently with a Notice of Appeal. Reconsideration of the pending claims 1-51 in the above-identified application is respectfully requested based on the following remarks.

Assignee contends that the Examiner has made a clear error in rejecting claims 1-51 for lack of enablement. Claims 1-51 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because "Applicant's claims are deemed unclear because the specific structure of the mechanism, which allows rotation in two orthogonal planes, is not clearly described in the Specification nor shown in the Drawings" (emphasis in the

Appl. No.: 10/619,535
Pre-Appeal Brief Request for Review
Dated October 10, 2005

original) Final Office Action (15 July 2005) at pages 2-3. *See also* Office Action (24 March 2005) at pages 2-3.

As an initial matter, the Examiner's threshold for "specific" structure in the rejection under 35 U.S.C. § 112, first paragraph, is without legal basis. Namely, there is no legal basis for requiring such "specific" structure in the specification. Rather, "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same..." 35 U.S.C. § 112, first paragraph. Moreover, there is no legal basis for requiring such "specific" structure in the drawings. Rather, "[t]he applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented." 35 U.S.C. § 113; *See also* 37 C.F.R. § 1.81. For at least these reasons, the rejection under 35 U.S.C. § 112, first paragraph, is without legal basis.

Second, the rejection under 35 U.S.C. § 112, first paragraph, fails to establish a reasonable basis to question the enablement provided for the claimed invention. By contending the specification and drawings lack "specific" structure, the rejection gives a single, simple determination as its basis for questioning the enablement of Applicant's specification. On its face, such a single, simple determination fails to establish a *prima facie* case of lack of enablement. *See* Reply (16 May 2005) at page 4; *See also* MPEP 2164.01(a) citing *In Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Furthermore, the rejection fails to provide any discussion of the factors for determining enablement as provided in MPEP

Appl. No.: 10/619,535
Pre-Appeal Brief Request for Review
Dated October 10, 2005

2164.01(a). Such factors include (A) the breadth of the claims, (B) the nature of the invention, (C) the state of the prior art, (D) the level of one of ordinary skill, (E) the level of predictability in the art, (F) the amount of direction provided by the inventor, (G) the existence of working examples, and (H) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. *See Reply* (16 May 2005) at pages 3-4. For at least these reasons, the rejection under 35 U.S.C. § 112, first paragraph, has insufficient basis.

Third, Assignee challenges the Examiner's contention that nothing within the scope of claims 1-51 is enabled. Claims 1-51 are enabled because the specification describes the subject matter of claims 1-51 in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention under 35 U.S.C. § 112. Even a cursory review of the specification and drawings indicate that the subject matter of claims 1-51 is enabled. By way of example only, Figures 2A-2B show and Paragraph [0020] describe a connector that has two connection mechanisms that allow the connector head to rotate in a Y-Z plane and to rotate in an X-Z plane. In addition, Figures 2A-2B show and Paragraph [0021] describes how the two connection mechanisms may be designed to retain a user-specified position and to hold that position until affirmatively altered. *See Reply* (16 May 2005) at page 4. Furthermore, Paragraph [0021] describes the connection mechanism as having "a hinge for rotation and friction for holding a connector in place;" "two mating planar surfaces to keep the rotation motion along a predetermined track or path and also increase the surface area for more stationary friction when a desirable position is reached;" or "a ball and socket universal joint similar in function to those used in conventional shower-heads." *See Id.* at pages 4-5. Thus,

Appl. No.: 10/619,535
Pre-Appeal Brief Request for Review
Dated October 10, 2005

Assignee's drawings showing connection mechanisms and Assignee's specification describing hinges, mating planar surfaces, and ball and socket universal joints directly refute the Examiner's single basis for rejecting claims 1-51 for enablement. For at least these reasons, the drawings and specification do enable one skilled in the art to make and/or use the subject matter related to the connection mechanisms coupling connector heads recited in claims 1-51.

Fourth, Assignee has asked the Examiner to provide an affidavit in compliance with 37 C.F.R. § 1.104(d)(2) if the rejection of claims 1-51 is based on the Examiner's personal knowledge. *See Id.* at page 5. The Examiner has not acknowledged this duty, and such an affidavit has not been provided. Rather, the Examiner states that "[o]ne with ordinary skill in the art would not be able to use or make this invention since there is not a specific explanation on how the mentioned examples could be applied in the present invention." Final Office Action (15 July 2005) at pages 3-4. This statement is simply an opinion by the Examiner and is not supported by an affidavit or any other form of support. Thus, Assignee believes that the rejection of claims 1-51 for lack of enablement lacks any support.

For at least these reasons, Assignee contends that the Examiner has made a clear error in rejecting claims 1-51 for lack of enablement, and Assignee respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

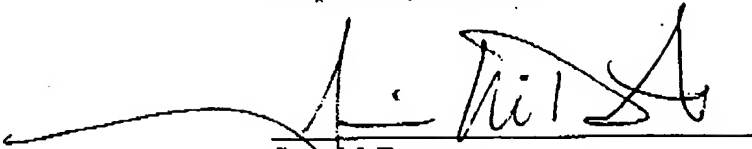
* * * * *

To facilitate the resolution of any issues or questions presented by this paper, Assignee respectfully requests that the undersigned be directly contacted by phone to further the discussion, reconsideration, and allowance of the claims.

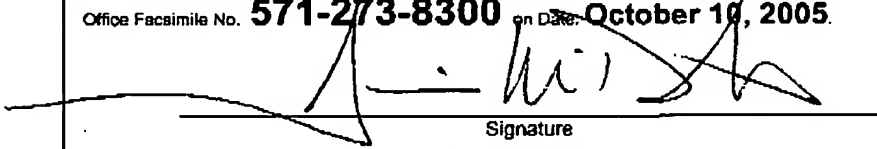
Appl. No.: 10/619,535
Pre-Appeal Brief Request for Review
Dated October 10, 2005

Respectfully submitted,

Date: October 10, 2005


Sean McDermott
Reg. No. 49,000

Customer No. 29855
Wong, Cabello, Lutsch,
Rutherford & Brucculeri, LLP
20333 State Highway 249, Suite 600
Houston, Texas 77070
Direct: 832/446-2416
Fax: 832/446-2424

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. 1.8	
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark	
Office Facsimile No. 571-273-8300	on Date: October 10, 2005.
	
Signature	
<u>Sean McDermott</u>	
Typed or Printed Name of Person Signing Certificate	